

Remarks/Arguments

This Amendment is made in response to the final Office Action dated May 7, 2009. The Office Action has been carefully reviewed, and the following remarks herein are considered responsive thereto.

Original claims 1–21 were examined and rejected via an initial Office Action dated August 5, 2008. In reply to the initial Office Action, original claims 1–21 were canceled and new claims 22–44 were presented via a Response filed on February 5, 2009. Claims 22–44 were examined and are pending in this application, prior to entry of this Amendment. Independent claim 22 has been amended by this Amendment to overcome the bases of rejection asserted in the Office Action and further to place the claims in condition for allowance. Additionally, dependent claims 25, 28, 31, 36, 39, 40, 43, and 44 have been amended, primarily due to the substantive amendments made to independent claim 22. No claims have been canceled and no new claims have been added by this Amendment.

It is submitted that no new matter is presented by this Amendment, as all claim amendments and new claims are properly supported by the application as originally filed. This Amendment is believed to have corrected all deficiencies so that a Notice of Allowance can be promptly issued.

Claim Rejections – 35 U.S.C. § 101

In the Office Action, claims 22–44 were rejected under 35 U.S.C. § 101 on the grounds that the claimed methods were allegedly directed to non-statutory subject matter. Specifically, the Examiner asserted that the process steps in claims 22–44 are not tied to a machine, nor do they execute a transformation.

According to the recently-decided *In re Bilski* decision (and as recited in the Office Action), in order for a claimed process to be considered patent-eligible subject matter under 35 U.S.C. § 101, the process must either (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. [*In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (citing *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972))]. Applicant asserts that the

present claims, as amended, are sufficiently tied to a particular machine, and thus withdrawal of the 35 U.S.C. § 101 rejection of the claims is respectfully requested. Applicant has not herein addressed whether the present claims transform a particular article to a different state or thing, as only one of the two *In re Bilski* factors must be met in order for the claims to qualify as patent-eligible subject matter. Further, Applicant notes that the *In re Bilski* case is currently pending before the U.S. Supreme Court, and that it is conceivable that the “machine or transformation” test may be changed or modified pursuant to the Supreme Court’s eventual decision in that case. However, Applicant contends that the present claims, and the amendments presented therein, satisfy the current *In re Bilski* “machine or transformation” test.

Specifically, independent claim 22 has been amended to state that certain claim steps are performed at an “intermediary claim management system”, and particularly “via a claim management system processor”. These claim amendments clarify that the processes described in claim 22 are carried out in a computerized system including at least a processor (i.e., a computer component), and are thereby tied to a particular machine. The *In re Bilski* decision left open the question of whether a computer suffices as a particular machine, stating “[w]e leave open to future cases the elaboration of the precise contours of machine implementation, as well as the answers to particular questions, such as whether or when recitation of a computer suffices to tie a process claim to a particular machine.” [*Id.* at 962]. Accordingly, because the *In re Bilski* court purposefully left open the question of whether a tie to a computer or specific computer components is sufficient to satisfy the “particular machine” inquiry, it is improper to reject independent claim 22 under 35 U.S.C. § 101. Further, because dependent claims 23–44 merely add additional limitations and details to independent claim 22, it is submitted that the rejection of these claims should also be withdrawn. Support for these amendments may be found in the originally-filed application in FIGS. 1–3, in the specification on pages 11–16, and in other locations not specifically mentioned.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 22–23 and 25–44 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Chapman et al.* (U.S. Patent No. 6,879,959) in view of *Little et*

al. (U.S. Patent No. 5,350,509), and in further view of *Provost et al.* (U.S. Patent No. 6,341,265). Further, in the Office Action, claim 24 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Chapman, Little, and Provost* in further view of *Wiggins* (U.S. Patent Pub. No. 200/0120473).

It is respectfully submitted that the cited references do not teach, suggest, or describe, alone or in combination, the method performed by the particular computer apparatus of independent claim 22 and, correspondingly, dependent claims 23–44, since the dependent claims merely add further limitations and details to the steps and structural components of independent claim 22.

Independent claim 22 generally describes the use of an intermediary claim management system that is designed and positioned between a conventional practice management computer system of a medical service provider and a conventional claims processing computer system of a medical insurance payer, whereby when the computer-implementable steps are performed, the quality of claims submitted by the medical service provider are improved and more likely to be approved for payment and whereby the approval is achieved more quickly due to the processes and steps performed by the particular computer apparatus of the intermediary claim management system.

In contrast, *Chapman*, which is the primary reference relied upon by the Examiner, describes a method of adjudicating medical claims based on scores that determine medical procedure monetary values. [See *Chapman*, Title and Abstract]. The adjudication process and system taught by *Chapman* is from the point of view of the payer, and is specifically directed to and teaches a very narrow and targeted system for determining the value of a medical claim. The system described by the present claims, and specifically the intermediary claim management system, is adapted to communicate with just such a payer system as described in *Chapman*. However, *Chapman* does not teach, describe or suggest the intermediary claim management system of the present claims or any of the process steps performed thereby. This is not surprising considering payer systems are designed and configured to reject claims and to slow down approval and payment determinations. In contrast, the intermediary claim management system of the present claims and the process steps described therein are designed and configured

to improve claims submitted for payment determinations, more quickly enable the medical service provider to update and correct a claim that has an identifiable error, and to speed up approval and payment determinations since claims are more likely to be in acceptable format by the time they are actually submitted to the claims processing system of the payer.

The *Little* reference, which is also relied upon by the Examiner, describes a health care payment adjudication and review system (similar to *Chapman*). [See *Little*, Title and Abstract]. Specifically, *Little* describes a conventional claims processing computer system of a medical insurance payer. As expected, the adjudication system of *Little* determines whether a claim should be approved and, if so, how much payment should be made on the reimbursement claim. In contrast, the intermediary claim management system described by the present claims and the process steps described therein do not make such determinations – they are designed to access whether the claim is in proper and reviewable format for the payer system, to monitor the status of such claim, and to provide meaningful and understandable feedback, status, and report information to the medical provider who is seeking payment on the claim.

The third reference cited by the Examiner, *Provost*, is directed to a conventional practice management computer system of a medical service provider wherein the practice management computer system communicates directly and with numerous back and forth communications with the claim processing system of the payer. Again, this is a conventional arrangement that is described in the background of the present application and which the system described by the present claims is specifically designed to improve.

None of the three cited references alone or in combination with each other describe, teach, or suggest a computer-implementable method for improving medical reimbursement claim processing between medical providers and insurance payers wherein an intermediary claim management system is in electronic communication between the practice management computer system of the respective provider and the claims processing computer system of the respective payer, as described by the present claims. Accordingly, Applicants assert that because *Chapman*, *Little*, or *Provost* (or any of the other cited references), whether taken alone or in combination, simply fail to teach, describe, or suggest the elements of independent claim 22, the 35 U.S.C. § 103(a) rejection of claim 22 premised on these references is improper and should be

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withdrawn.

Additionally, although not specifically discussed, because the dependent claims in the application merely provide additional elements or limitations to the independent claims from which they depend, they should also be allowable, on their own merits as providing unique additional functionality, and separately under the doctrine of *In re Fine*, 5 U.S.P.Q.2d 1597 (Fed. Cir. 1988), which stands for the proposition that if an independent claim is patentable, a dependent claim should also be patentable as it provides further limitations to the independent claim from which it depends.

For the sake of brevity, not every claim or claim element and its associated rejection has been discussed in this Amendment. However, Applicants do not acquiesce in any of the Examiner's assertions and comparisons regarding the cited references and the present claims, regardless of whether they have been specifically addressed in this Amendment.

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Conclusion

The foregoing is presented as a full and complete response to the Office Action mailed May 7, 2009, and is believed to have placed claims 22–44 in condition for allowance. Such action is courteously solicited. If any issues remain that can be resolved by telephone, the examiner is respectfully requested to contact the undersigned at 404-364-7421.


Additionally, please note that the current Amendment includes 23 total claims and 1 independent claim. Because Applicants previously paid for 23 total claims and 3 independent claims, no additional claims fees are believed due. However, Applicants hereby request and pay the appropriate fee for a three (3) month extension of time within which to file this response, as well as the fee for a Request for Continued Examination (RCE). If our assessment of additional fees due is in error, please charge any fees that might be due or credit any overpayment to our Deposit Account No. 50-3537.

It is now believed that the application is in condition for allowance and such allowance is respectfully requested.

Respectfully submitted,

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